

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

BRIEF FOR APPELLEE

**United States Court of Appeals
for the District of Columbia Circuit**

Appeal No. 11530

NELLIE PAULINE FLETCHER AND WILLIAM ARTHUR
FLETCHER, *Appellants*

v.

ROBERT C. WATSON

~~JOHN A. MARZALL~~, COMMISSIONER OF PATENTS
Appellee

Appeal from the Judgment of the United States District Court for the
District of Columbia

E. L. REYNOLDS,
*Solicitor, United States Patent Office,
Attorney for Appellee.*

H. S. MILLER,
Of Counsel.

Appeal No. 11530

THE QUESTION PRESENTED

In the opinion of the appellee, the question presented is whether the District Court was right in refusing to allow the claims in appellants' application for patent, which question is resolved should this Court find proper any one or more of the three grounds of refusal applied by the Patent Office tribunals and sustained by the District Court, namely (1) that the disclosure of the application is not sufficiently definitive to enable those skilled in the art to practice the alleged invention, (2) that the claims of the application are based upon a disclosure which is inoperative and (3) that the claims are based upon a disclosure which is not sufficiently useful and important to support a patent.

INDEX

	Page
Counterstatement of the Case -----	1
Statute Involved -----	3
Summary of Argument -----	3
Argument -----	4
Conclusion -----	9

AUTHORITIES CITED

CASES:

<i>Abbott et al. v. Coe</i> , 71 App. D. C. 195, 109 F. 2d 449 -----	5, 9
<i>Blackmore, In re</i> , 32 App. D. C. 338 -----	5
<i>Fletcher and Fletcher, In re</i> , 84 USPQ 386 -----	8
<i>Fletcher et al. v. U. S. Atomic Energy Commission</i> , 89 U. S. App. D. C. 218, 192 F. 2d 29 -----	2, 3, 6, 7

STATUTES:

4888 R. S. (35 U. S. C. 33) -----	4, 5
4893 R. S. (35 U. S. C. 36) -----	2, 3, 6
4915 R. S. (35 U. S. C. 63) -----	9

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**JOHN A. MARZALL, COMMISSIONER OF PATENTS
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BRIEF FOR THE COMMISSIONER OF PATENTS

COUNTERSTATEMENT OF THE CASE

The appellants here filed the application in suit requesting the issuance of a patent thereon. The Primary Examiner in the Patent Office rejected claims 1 to 39, inclusive, for the reasons set forth in the Examiner's Statement (Defendant's Exhibit No. 1, Item B, which exhibit is not reproduced in the transcript of record, but was certified to this Court in its original form, in view of the Order, Tr. 27, of the District Court.

The Examiner held that the specification of the application in suit fails to disclose the subject matter with such full, clear, concise and exact terms as to enable those skilled in the art to practice the alleged invention. The Examiner also held that the method and apparatus as described in the specification of the application in suit are inoperative to produce the results claimed therefor. The Examiner further held that the rejected claims are drawn to subject matter which is not sufficiently useful and important to support a patent within the meaning of Sec. 4893 R. S. (35 U. S. C. 36).

The Board of Appeals affirmed the Examiner's rejection of the claims on all three grounds (Defendant's Exhibit No. 1, Item C, Decision of the Board).

Present appellants filed their complaint (Tr. 1) in the District Court. Trial was had at which the proceedings were taken down stenographically, but not transcribed, so the transcript of record contains no copy of the proceedings. Appellants, as plaintiffs below, produced no witnesses for examination, but relied upon certain documentary exhibits, as well as physical exhibits (Tr. 9) which were before this Court in Appeal No. 10587, *Fletcher et al. v. U. S. Atomic Energy Commission*, 89 U. S. App. D. C. 218, 192 F. 2d 29. On the basis of the exhibits presented, the District Court rendered an opinion (Tr. 10) adopting as controlling the conclusions previously reached by the Patent Office tribunals and dismissing the suit. The District Court filed Findings of Fact and Conclusions of Law (Tr. 11) and a judgment (Tr. 15) dismissing the complaint.

STATUTE INVOLVED

4893 R. S. (35 U. S. C. 36)

On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and, if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

SUMMARY OF ARGUMENT

1. The specification of the application in suit fails to disclose the subject matter in such full, clear, concise and exact terms as to enable those skilled in the art to practice the alleged invention.
2. The method and apparatus as described in the specification of the application in suit are inoperative to produce the results claimed therefor.
3. The rejected claims are drawn to subject matter which is not sufficiently useful and important to support a patent within the meaning of Sec. 4893 R. S. (35 U. S. C. 36).
4. The decision of this Court in the case of *Fletcher et al. v. U. S. Atomic Energy Commission*, 89 U. S. App. D. C. 218, 192 F. 2d 29, which involved the identical application for patent here in suit, is at least highly persuasive, if not controlling, in the case at bar.

ARGUMENT

1. The drawings of the application in suit (Defendant's Exhibit No. 1, Item A) do disclose certain apparatus. The specification of the application also does allege, in broad language, certain methods or processes said to be carried out by the use of the apparatus disclosed.

It is submitted, however, that the specification fails to disclose the subject matter in such full, clear, concise and exact terms as to enable those skilled in the art to practice the invention as required by Sec. 4888 R. S., 35 U. S. C. 33 (Reproduced at page 4 of appellants' brief). This is the first ground of rejection applied by the Examiner (Defendant's Exhibit No. 1, Item B, Examiner's Statement, page 10). Appellants at page 11 of their brief refer to the "Examiner's inability to understand the disclosure." However, the ability of the Examiner is not an issue in this case. The application disclosure is before the Court. That disclosure cannot be changed by the opinion of a Mr. Backus, heavily relied upon throughout appellants' brief. As before noted, no witnesses were presented for examination before the District Court. The opinion of Mr. Backus is merely in the documentary exhibits presented by plaintiffs below, without objection, for whatever value, if any, they might, in the opinion of the District Court, have upon the case.

The Board of Appeals agreed with this first ground of rejection as applied by the Examiner (Defendant's Exhibit No. 1, Item C, Decision of the Board).

The District Court expressly found as a fact, in Finding of Fact No. 6 (Tr. 12) that "The specification

of the application in suit fails to disclose the subject matter with such full, clear, concise and exact terms as to enable those skilled in the art to practice the alleged invention." Unless the specification meets the just quoted requirements, grant of a patent is not authorized under R. S. 4888 (35 U. S. C. 33).

A rejection by the Patent Office on the ground that the specification of the application for patent failed to define the claimed invention with such clarity as to enable one skilled in the art to practice it was upheld by the Court of Appeals for the District of Columbia. *In re Blackmore*, 32 App. D. C. 338. Furthermore, as said in the case of *Abbott et al. v. Coe*, 71 App. D. C. 195, 109 F. 2d 449, "Moreover, even invention is not patentable unless it is disclosed so that people can use it."

2. It is next submitted that the method and apparatus as described in the specification of the application are inoperative to produce the results claimed therefor. This is the Examiner's second ground of rejection as applied in his statement (Defendant's Exhibit No. 1, Item B, Examiner's Statement, page 11). The Board of Appeals was in agreement with this ground of rejection (Defendant's Exhibit No. 1, Item C, Decision of Board).

The record shows that certain models (Tr. 9) were before the District Court which had earlier been before the United States Court of Appeals for the District of Columbia in a case involving the same application for patent as is involved in the case at bar. The District Court, during the trial below, repeatedly

suggested to appellants that a demonstration of the operation of the models be made.

However, appellants did not favor the District Court with any demonstration of the operation of the models of the alleged invention. On this state of facts, it is submitted that the District Court properly entered Finding of Fact No. 7 (Tr. 12) that "The method and apparatus as described in the specification of the application in suit, on the evidence before the Court, are inoperative to produce the results claimed therefor." It is also submitted that the District Court properly entered Finding of Fact No. 4 (Tr. 12) that "An examination of the plaintiffs' application in suit, specification and drawings, fails to disclose clearly how the device will operate, or whether in fact it will operate at all."

3. It is submitted that the rejected claims are drawn to subject matter which is not sufficiently useful and important to support a patent within the meaning of Sec. 4893 R. S. (35 U. S. C. 36). This is the Examiner's third ground of rejection (Defendant's Exhibit No. 1, Item B, Examiner's Statement, page 11). It was affirmed by the Board of Appeals. It is submitted that the District Court properly entered Finding of Fact No. 8 (Tr. 13) that "The rejected claims, on the evidence before the Court, are drawn to subject matter which is not sufficiently useful and important to support a patent, within the meaning of Sec. 4893 R. S. (35 U. S. C. 36)."

4. As hereinbefore indicated, the application here in suit was before this Court in the case of *Fletcher*

et al. v. U. S. Atomic Energy Commission, supra. Appellants at page 1 of their brief refer to a "Patent 1,715,382. May 28, 1929," said to have been issued to one of appellants.

However, the public records in the Patent Office show that patent No. 1,715,382 was issued to R. S. Peelle on June 4, 1929. There is a patent, No. 1,715,283, issued to W. A. Fletcher on May 28, 1929, which patent was also involved in the prior case of this Court just referred to, along with the instant application. The issue in the prior case was not whether appellants were entitled to a patent upon the application here in suit. The issue there, however, did involve the question of whether appellants were entitled to compensation for the alleged invention of the application now in suit. In reaching a conclusion upon that matter, it was necessary to pass upon the sufficiency and operativeness of the disclosure of the application at bar. The final decision of this Court upon that matter is, therefore, at least highly persuasive, if not controlling, in the case at bar.

This Court pointed out that "an award may not be granted unless there has been a complete disclosure of the invention or discovery to the Commission or to the Patent Office * * *." This Court additionally referred to the finding of the Commission that "the alleged inventions and discoveries of the petitioners were not useful in the production of fissionable material or in the utilization of fissionable material or atomic energy for a military weapon," and held that there was ample evidence to support this finding.

The decision of the Commission, by the Patent Compensation Board, which was reviewed by this Court, is published under the title *In re Fletcher and Fletcher* in 84 USPQ 386. In finding of fact No. 1 it refers to application Serial No. 614,880 which is appellants' application at bar. Under the section "The Fletcher Applications as a Basis of Claim," the Commission referred to the same application, reproduced the Examiner's grounds of rejection and noted that the Board of Appeals affirmed the Examiner's rejection. The Commission then ruled that "the applications upon which this portion of the claim is based present a common difficulty, a lack of disclosure of identifiable methods or structures which could be tested against the practices of the Atomic Energy Commission or the known nuclear phenomena to determine whether the disclosed arts bring the applications within the terms of the Atomic Energy Act, and, if so, the valuation to be placed upon them. * * * At the hearing applicants were given full opportunity to translate the disclosures made in the applications into a comprehensible definition of the structures and phenomena involved. This effort yielded little more, if anything, than is evident from the documents."

The appellants do not mention the foregoing case in their brief, nor is any attempt made to explain away its damaging holdings against the appellants here in respect to the matter of sufficiency of application disclosure, which is a major issue in the suit at bar.

Appellants' brief concludes with a request at page 17 that "the judgment below should be reversed and

the Commissioner of Patents should be authorized and directed to grant the patents as prayed for in the complaint." However, the only relief obtainable by 4915 R. S., 35 U. S. C. 63 (reproduced at page 4 of appellants' brief), under which the complaint was filed, is an adjudication which, "if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law."

It is submitted that there is a rational basis for the concurring opinions of the Patent Office tribunals and the District Court, which has not been overcome by appellants with the clear proof of mistake required for reversal under the ruling of this Court in *Abbott et al. v. Coe*, 71 App. D. C. 195, at page 197, 109 F. 2d 449.

CONCLUSION

In consequence it is therefore respectfully submitted that the judgment from which appeal has been taken is correct and should be affirmed.

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NOVEMBER 1952.